UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,094	05/09/2001	Mark R. Dee	36861.00.0006	5243

7590 06/18/2007

Angelo J. Bufalino
VEDDER PRICE KAUFMAN & KAMMHOLZ
222 N. LaSalle Street
Chicago, IL 60601

EXAMINER	
RUHL, DENNIS WILLIAM	

ART UNIT	PAPER NUMBER
3629	

MAIL DATE	DELIVERY MODE
06/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/853,094	DEE, MARK R.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2006 and 29 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5,18-22 and 50-91* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *5,18-22,50-91* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/06 has been entered.

2. The amendment filed 12/21/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: See the 112,1st rejection where this has been addressed by the examiner. The objection to the amendment is for claim 91 and the same reason as set forth in the 112,1st rejection.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 20-22,56,58,62-67,77-80,85,86, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claims 20-22,56,58,62-67,77-80,85,86, applicant is reciting a method step of using the recited structure of the system. This is improper because a claim can only fall into one statutory class of invention at one time. This claim is dependent from an

apparatus claim but is reciting a method step by using recited structure of the system, which is a mixing of two distinct statutory classes of invention. This renders the claims as non-statutory.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 91 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot find a disclosure of what is recited in claim 91. Page 21 of the specification as originally filed discloses that the central billing database processes information and makes an appropriate adjustment to the amount "to be charged the user for parking". It is not disclosed in the specification as originally filed that a "central processing means" has the ability to refund money for time not spent. The closest disclosure is that of adjusting the amount that is to be charged. There is no disclosure that the amount is refunded, it is disclosed as being adjusted prior to charging. Claim 91 appears to be new matter. The examiner requests that applicant point out where support can be found for this newly added limitation.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 20-22,56,58,62-67,77-80,85,86, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 20, one wishing to avoid infringement would not know the scope of the claim. The reason is that one wishing to avoid infringement would not know whether or not they were infringing by just possessing the claimed structure of the invention, or if they were infringing only when using the claimed device in the claimed manner. The claim is indefinite for this reason. The examiner notes that applicant changed the claim from reciting functional language to now reciting the actual performing of the step. Also in claim 20, what is meant by the language "by entering the reference identifier into the wireless ticket issuance device"? Is this supposed to mean that when the reference identifier is a license plate, that the license plate is removed from the vehicle and is placed inside the ticket device? The reference identifier is a tangible element of the system so it is not clear to the examiner how applicant can claim that the reference identifier is entered into the ticket device. It may be that information obtained from the reference identifier can be entered into the ticket device, but that is not what the claim is reciting. Correction is required.

For claims 21,22,56,58,62-67,77-80,85,86, one wishing to avoid infringement would not know the scope of the claim. The reason is that one wishing to avoid infringement would not know whether or not they were infringing by just possessing the

claimed structure of the invention, or if they were infringing only when using the claimed device in the claimed manner. The claim is indefinite for this reason. The examiner notes that applicant changed the claim from reciting functional language to now reciting the actual performing of the step.

For claim 70, there is no antecedent basis for "the parking place". It is not clear what this is referring to because no parking place has previously been claimed.

For claim 71, it is not clear as to what is meant by and what structure is covered by the language "includes a means for *geographic positioning of the parking space*". What does this mean? Is the parking space being moved or repositioned? What is meant by means for geographic positioning? What structure is covered by this language? What is the structure from the specification that relates to this language? The examiner cannot find this in the specification unless applicant is attempting to claim the number that the spaces are to have in the sense that the number can identify location, but this was already claimed in claim 70. Claim 71 is indefinite and the means for geographic positioning has been interpreted to be the same as a space number, as this is best understood by the examiner.

For claim 76, the language "can add extra time *with respect to the reference identifier*" is not clear. What does this mean? What does the reference identifier have to do with time, especially when the reference identifier can by the VIN of the vehicle. It is not clear as to what this portion of the claim is reciting.

9. Claims 70-91 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 70-91 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed 12/21/06 and 3/29/07. In that paper, applicant has stated that claims 70-91 are allowable because the prior art does not disclose a wireless communication means and has also stated that the previously made arguments are equally applicable to claim 70, and this statement indicates that the invention is different from what is defined in the claim(s) because the claims do not require a reference identifier that has wireless communication means. The arguments that were filed with the RCE only addressed the issue of the smart card having a wireless communication means. This is what applicant stated as rendering the claims as novel. The response filed 3/29/07 also makes this argument about the smart card very briefly, and applies this same argument to claim 70, that requires no such limitation. The previous arguments that applicant wants applied to claims 70-91 with equal force are based on a limitation that is not even in claim 70.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 5,18-22,50-58,60-86,88-91, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet et al. (WO 97/37328) in view of Zeitman (WO 98/04080).

For claims 50,57,60,61,62,63,66,67, Ouimet discloses a parking payment system. There is inherently a vehicle, an occupant, a space and a location as claimed. The claimed reference identifier is considered to be the motorist "smart card" that is disclosed by Ouimet on page 6; however, it is not disclosed that the motorist smart card has wireless communication means as is claimed in claim 50. The wireless ticket issuance device is 18, and communicates with a central processing means 16. The parking meter is 12 and has wireless communication means 41. The parking meter and the central processing means can credit the central processing means with payment received as claimed. The central processing means (computer 16), tracks credits for payment received as claimed, records start times for parking (so you can determine when a vehicle is illegally parked due to exceeding the time paid for parking), communicates status information to the wireless ticket devices 18, and records ticket information as claimed.

Not disclosed is that there is a communication means to be used by the occupant to communicate with the central processing means. Also not disclosed is that the

motorist smart card (from pg 6 of Ouimet) has wireless communication means as is claimed in claim 50.

With respect to the smart card having wireless communication means, one of ordinary skill in the art would clearly recognize that smart cards can either be contact type of non contact type. Applicant's most recent argument that a smart card does not inherently have a wireless communication means, is persuasive, but at the same time also is further evidence of the fact that smart cards can be contact type or wireless type. The examiner takes "official notice" that it was well known in the prior art to use contactless type smart cards (with wireless communication means) in addition to using contact type of smart cards. Both were known in the art prior to the filing of the instant application. The examiner has cited examples of evidence that supports this position at the end of this office action. Taking into account that Ouimet discloses the use of a smart card (may be contactless or contact type, nothing further disclosed by Ouimet) and taking into account that one of ordinary skill in the art at the time the invention was made would have been aware of and understood the fact that smart cards also come in a contactless type that has wireless communication means, one of ordinary skill in the art would have found it obvious to use a smart card that has wireless communication means as an alternate to the contact type of smart card used in Ouimet. Both types of smart cards were known in the art and to simply use a contactless type of smart card e is something that one of ordinary skill in the art would have understood and would have found obvious. A reason for doing this would be for the advantages that having wireless devices provides. They are easier to use in that they communicate data wirelessly.

One of ordinary skill in the art would have clearly appreciated the desirability of using a smart card with wireless communication means as is claimed.

Zeitman discloses a parking management system that has a high level of user convenience. Zeitman discloses that the user can directly communicate with a central computer system by using their mobile telephone or a computer, and can provide the information such as vehicle space and time information by using their telephone. This would allow for more user convenience when conducting the parking space use transaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Ouimet with the ability to take user information by a communication means (telephone, computer) as is disclosed by Zeitman so that the user has another convenient method by which to conduct the parking transaction.

For claim 5, the parking location can be reference by means of geographic positioning. This claim is not reciting any further structure to the system of claim 50. The manner in which the parking location is determined is not relevant to the system.

For claims 18,56,64, the 103 rejection results in a communication means that can communicate with the central processing means to add extra time as claimed. This feature is present in the resulting structure of the 103 combination.

For claims 19,65, the communication means is fully capable of being notified as claimed. The prior art has the ability to perform the functional recitation claimed.

For claims 20,21,22, as best understood by the examiner the prior art satisfies what is claimed. This is because the time status information is verified by the ticket machine in Ouimet by acquiring data about the vehicle. The manner in which that

information is obtained is not given weight in an apparatus claim because that has to do with the method of use.

For claims 51-55,68,69, the prior art rejection results in the claimed structure. This is because the communication means of Zeitman (that was provided to the system of Ouimet) is disclosed as being a telephone (cell phone or landline) as well as a computer. This can be seen figure 1 of Zeitman. A computer and/or a cell phone can be considered as personal data assistants. The disclosed telephones are considered to be paging devices.

With respect to claim 58, reciting whom it is that issued the reference identifier is not seen as reciting any further structure to the system. Claiming whom the reference identifier is issued from is not reciting any particular structure to the system or the reference identifier.

For claims 70,71,81-85,88-90, Ouimet discloses a parking payment system. There is inherently a vehicle, an occupant, a space and a location as claimed. The claimed reference identifier can be considered to be the motorist "smart card" that is disclosed by Ouimet on page 6, or can be any other vehicle identifying data that would identify the vehicle, such as a vehicle identification number (VIN) or even a license plate number. The specification sets forth that the reference identifier can be the VIN of the vehicle, which is just a number, so the scope of the term "reference identifier" is very broad and can be just a number and is not even required to be a real world tangible thing. The wireless ticket issuance device is 18, and communicates with a central processing means 16. The parking meter is 12 and has wireless communication means

41. The parking meter can receive credits, process payments, record payment times, etc., as claimed. The parking meter and the central processing means can credit the central processing means with payment received as claimed. The central processing means (computer 16), tracks credits for payment received as claimed, records start times for parking (so you can determine when a vehicle is illegally parked due to exceeding the time paid for parking), communicates status information to the wireless ticket devices 18, and records ticket information as claimed. With respect to the language "for communicating the reference identifier and geographical identifier number and making a payment", this is directed to the intended use of the system and is not taken as defining any further structure to the claimed system. This language has more to do with how the system is intended to be used than what the system is made up of structurally.

Not disclosed is that there is a communication means to be used by the occupant to communicate with the central processing means. Not disclosed is that the communication means is able to obtain and display parking status and time as claimed. Not disclosed is that the parking space has a geographic identifier number.

With respect to the parking space having a number, the examiner takes "official notice" that it is old and well known to have parking spaces numbered. This is nothing new. Spaces are numbered in city jurisdictions, in parking garages, in townhouse developments, etc.. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the parking space with a number, so that each space is identified by a number. That is the reason you put numbers in spaces, so the

spaces are labeled in some understandable manner. This would have been obvious to one of ordinary skill in the art.

Zeitman discloses a parking management system that has a high level of user convenience. Zeitman discloses that the user can directly communicate with a central computer system by using their mobile telephone or a computer, and can provide the information such as vehicle space and time information by using their telephone. Users can also reserve parking spaces in advance by using their telephones or computers (personal data assistants, paging devices, cl 83,84). The use of a telephone provides more user convenience when conducting the parking space use transaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Ouimet with the ability to take user information by a communication means (telephone, computer) as is disclosed by Zeitman so that the user has another convenient method by which to conduct the parking transaction. With respect to the communication means being able to obtain and display the parking status and the parking meter credit time (start time), one of ordinary skill in the art would have further found it desirable to allow the user to also use the communication means to obtain parking status information as well as information on parking start time because this is information that one would reasonably find to be of interest to a person parked at a parking meter. If one were using a communication means (such as a phone) to allow a user to reserve a space and pay for parking in a space, to allow the user to also obtain parking status time (such as is provided to the parking enforcement officer in both applied references) and start time would have been something that one of ordinary skill

in the art would have found obvious. Providing an update on the parking status and the parking start time is something that is within the knowledge of one of ordinary skill in the art.

For claims 72,73, not disclosed is that the reference identifier is a tag display on the vehicle, or a reference tag with a bar code. The prior art to Ouimet recognizes and discloses that vehicle identification data must be entered by the user, see page 6. The user must identify the vehicle and user entered data is disclosed as being provided that allows for vehicle identification. The claimed reference identifier does the same thing, it is identifying data that identifies the vehicle. When the reference identifier is a VIN, this is a number that identifies the vehicle, just like a tag with a number displayed on the vehicle would. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the reference identifier be a reference tag with identifying data, or a tag with a bar code, so that identifying data of some kind is received that would allow one to identify the parked vehicle upon visual inspection by a parking officer. Hang tags for vehicles is old and well known in the art. Additionally, the examiner notes that there is no specific problem being solved by having the reference identifier be the claimed types, and there is no unexpected result associated with their individual use, therefore, they are taken as a choice in system design. The claimed reference identifier identifies the vehicle, something that the prior art recognizes in a broad sense.

For claim 75, if one wanted to, they could make the reference identifier be a VIN. Claiming that it can be this is not the same as claiming that it is this.

For claim 76, not disclosed is that the communication means is able to add extra time by updating the central processing means during the time period claimed (assumed to be during a time when the meter still has paid time left and has not yet expired). It is well known in parking meter art that once a user parks their car, they can go back to the meter and add more money to buy more time. The examiner takes "official notice" of the fact that it is routine for people to go to a meter prior to the time expiring to buy more time on the meter. This is something that would have most likely taken place manually with the more well known and older types of meters that were purely mechanical. One of ordinary skill in the art who uses the communication means of Ouimet to allow a person to initially pay for parking, as the prior art rejection results in, would also find it obvious to also allow a user to utilize the communication means to purchase extra time for the meter. As stated previously, the act of adding more time to a parking meter is known in the art (although in a manual sense), and in the prior art rejection the user uses the communication means to pay for parking, so one of ordinary skill in the art would have found it obvious to also allow the user to use the communication means to pay for extra time by updating the central processing means.

For claim 77, not disclosed is that the user is notified by the central processing means that the time is about to expire. The examiner takes "official notice" that it is old and well known in the art to notify customers of the fact that something is about to expire, especially from time periods. It is well known in the art to notify an account holder that has fees automatically charged to a credit card, that their current credit card is about to expire. This is done so that the business can continue to charge fees to a

valid credit card whose allowable time of use has not expired. It is also known in the art to notify customers of the fact that a time period is about to expire, like a service period for a warranty or other services. Subscribers to services are notified when their current subscription is about to expire. The overall idea of notifying a customer that something is about to expire (time period, credit card, etc.) is very well known in the art. One of ordinary skill in the art would have recognized that from the customer's standpoint, it would be advantageous to be notified that your time is about to expire, so that they can add extra time to the meter to avoid getting a ticket. This is something that one of ordinary skill in the art would have recognized based on common sense and the knowledge that one of ordinary skill in the art has in their possession.

For claims 74,78, Ouimet discloses that the parking warden can simply enter the license plate number of a vehicle to obtain parking status information. See page 8 last paragraph. The act of entering a reference identifier (vehicle identification data in the form of a license plate number) to obtain parking status information is disclosed by Ouimet. Clearly, if the parking warden is able to enter the license plate number to obtain the parking status information for that vehicle, then it necessarily follows that the license plate number would have to have been entered by the user at some point for purposes of vehicle identification. This satisfies what is claimed in claim 74 and claim 78.

For claim 79, when the reference identifier includes a bar code (as was addressed for claim 73, then it follows that one would enter the bar code data to obtain the parking status information. Ouimet discloses that the parking warden can simply

enter the license plate number of a vehicle to obtain parking status information. See page 8 last paragraph. When a barcode is used, which is considered obvious, then if follows that one would scan the bar code to subsequently obtain the parking status for that vehicle.

For claim 80, not disclosed is that the reference identifier (i.e. the motorist smart card from pg 6 of Ouimet) has wireless communication means. One of ordinary skill in the art would clearly recognize that smart cards can either be contact type of non contact type. Applicant's most recent argument that a smart card does not inherently have a wireless communication means, is persuasive, but at the same time also is further evidence of the fact that smart cards can be contact type or wireless type. The examiner takes "official notice" that it was well known in the prior art to use contactless type smart cards (with wireless communication means) in addition to using contact type of smart cards. Both were known in the art prior to the filing of the instant application. The examiner has cited examples of evidence that supports this position at the end of this office action. Taking into account that Ouimet discloses the use of a smart card (may be contactless or contact type, nothing further disclosed by Ouimet) and taking into account that one of ordinary skill in the art at the time the invention was made would have been aware of and understood the fact that smart cards also come in a contactless type that has wireless communication means, one of ordinary skill in the art would have found it obvious to use a smart card that has wireless communication means as an alternate to the contact type of smart card used in Ouimet. Both types of smart cards were known in the art and to simply use a contactless type of smart card e

is something that one of ordinary skill in the art would have understood and would have found obvious. A reason for doing this would be for the advantages that having wireless devices provides. They are easier to use in that they communicate data wirelessly. One of ordinary skill in the art would have clearly appreciated the desirability of using a smart card with wireless communication means as is claimed.

For claim 86, the recitation of whom it is that issued the reference identifier is not something that further defines any structure to the reference identifier itself, especially in an apparatus type of claim where structure is considered and not method steps. The prior art satisfies what is claimed.

For claim 91, not disclosed is that the central processing means allows for the refund of time not spent. The examiner interprets this to be the ability of the central processing means to credit the account of a user, as opposed to charging the account of a user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the central processing means with the ability to refund money, so that in the event a customer is incorrectly charged, they can be refunded any incorrectly charged monies. Providing the central processing means with the ability to credit account with a refund is considered obvious.

12. Claims 59,87, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet et al. (WO 97/37328) in view of Zeitman (WO 98/04080) and further in view of Hassett (5351187).

For claims 59,87, not disclosed in the 103 combination is that the reference identifier is a radio frequency transponder. In Ouimet the reference identifier (the smart card that contains vehicle data and pre loaded parking funds) can be used to pay for parking by using pre-paid funds loaded onto the card. Hassett discloses a parking payment system where the user has a radio frequency transponder for their vehicle, where the transponder is preloaded with funds to be used to pay for parking. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the reference identifier a radio frequency transponder as disclosed by Hassett because the transponder works in the same way as the smart card of Ouimet does and is considered to be a functional equivalent to the smart card. One of ordinary skill in the art would have found the use of the transponder as obvious. The transponder is just another way to use technology to accomplish the payment of parking funds, just like the smart card of Ouimet does.

13. Applicant's arguments filed 12/21/06, 3/29/07, and in the previous after final amendments have been fully considered but they are not persuasive.

With respect to the 101 rejection, the arguments presented previously are not persuasive. The claims are reciting method steps where actions are taking place. This is claiming a method step as part of a system claim, which is not statutory. The claims cannot recite structure of a system and then use that recited structure in a method step, this is improper.

With respect to the 112,2nd rejection for claims 20-22,56,58,63-67, is the claimed method required to infringe or not? It is not clear if infringement would occur by just having the system, or if the system were to operate as is claimed in these claims.

With respect to the traversal of the prior art rejection, the entire argument is that Ouimet does not disclose a smart card with wireless communication means. The argument that it is not inherent that the motorist smart card be contactless is noted and is found persuasive. However, this is still not a patentably distinguishing limitation because this small difference is obvious to one of ordinary skill in the art. Smart cards where invented years ago and smart cards with wireless communication means have been in public use for many years, such as the Octopus type of contactless smart cards that have been in use in Japan since the 1990s. Contactless types of smart cards were known in the prior art prior to 5/9/2000, the filing date of this application. The argument that Ouimet teaches away from using a contactless smart card is noted but is not persuasive, especially because this is in reference to figure 5 which has nothing to do with the motorist smart card. However, applicant has not provided any explanation as to how the reference would be destroyed by the modification or how it would not work if modified as is set forth in the rejection. The general allegation that the reference teaches away is not persuasive. The arguments about another patent being granted for the use of contactless smart cards is noted but is not seen as relevant to the issues at hand. This has nothing to do with the instant application, each application stands on its own. The rejection is deemed proper.

With respect to the argument for newly added claims 70-91, the arguments are somewhat confusing. Applicant has argued that claims 70-91 are allowable because of the limitation of a wireless communication means, as was argued for claim 50. Applicant has stated that at the time of invention it was not known to use a wireless type of smart card. This is more or less arguing that the applicant invented a wireless smart card, something which is not factually supported by the prosecution record and clearly not supported by the prior art dealing with smart cards. The instant applicant did not invent the wireless smart card. Applicant argues that claim 70 requires a wireless communication means and that the previous arguments are equally applicable to claim 70. Claim 70 does not require a reference identifier that has wireless communication means, all that is claimed is a reference identifier in a generic sense. The element that applicant believes renders the claims patentable is not even in claim 70, so the argument is moot based on it not being commensurate with the scope of claim 70. Applicant has stated that the arguments concerning the wireless smart card are applicable to claim 70, but claim 70 has a scope that allows for the reference identifier to be a number and does not even require a reference identifier that has wireless communication means. The argument for claims 70-91 is not persuasive because the argued limitation is not in the scope of the claims.

The examiner takes notice that the actual 103 rejection and reasoning for combining the two references has not been traversed on the merits (Ouimet in view of Zeitman). The patentability of the claims comes down to the issue of whether or not it is obvious to have the smart card of Ouimet being a contactless type of smart card. This

is the only argument applicant has presented for patentability. The examiner finds the obviousness statement that combines Ouimet with Zeitman and the resulting 103 combination to be proper because it was not argued as being incorrect. See 37 CFR 1.111. The same is true for the 103 rejection involving the reference to Hassett. Applicant has not addressed this rejection at all, so it must be assume to be proper because otherwise, 37 CFR 1.111 requires a showing of the errors in the rejection. No traversal has been made on the merits for the 103 rejection involving the Hassett reference.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Hanaro Card", "Octopus Cards Ltd.", and "Smart Card" disclose smart cards and discuss prior art in public use contactless types of smart cards. This is evidence that smart cards where known to be wireless prior to the filing date of the instant application. Maropis et al. (20020061902) discloses that a subscriber is notified when the customers service time period is about to expire.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DENNIS RUHL
PRIMARY EXAMINER